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10/596,854	06/27/2006	Frank Bastiaan Brouwer	P16272-US1	1356
27045	7590	05/15/2009		
ERICSSON INC. 6300 LEGACY DRIVE M/S EVR 1-C-11 PLANO, TX 75024			EXAMINER CUMMING, WILLIAM D	
			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, all the claimed method steps as claimed in claims 2-16, all the claimed means in the base station as stated in claims 25 and all the claimed means as stated in claims 35-40 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "*Replacement Sheet*" or "*New Sheet*" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. The drawings were received on October 1, 2008. These drawings are disapproved approved.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 2-16 and 25-40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification inadequately describe all the claimed method steps as claimed in claims 2-16 and all the claimed means in the base station as stated in claims 25 and all the claimed means as stated in claims 35-40. The "*written description*" of the invention required by first paragraph of 35 USC §112 is separate and distinct from that paragraph's requirement of enabling disclosure, since description must do more than merely provide explanation of how to "*make and use*" the invention. Applicant must also convey, with reasonable clarity to those skilled in the art, that applicant, as of the filing date sought, was in possession of the invention, with the invention being, for purpose of "*written*

description" inquiry, whatever is presently claimed. Drawings alone may, under proper circumstances, provide "*written description*" of the invention required by 35 USC §112, and whether the drawings are from design application or utility application is not determinative. In order to satisfy "*written description*" requirement of 35 USC §112, the proper test is whether drawings conveys, with reasonable clarity to those of ordinary skill in the art, the claim subject matter.

5. Claims 25-40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification does not provide an enabling disclosure all the claimed means in the base station as stated in claims 25 and all the claimed means as stated in claims 35-40. The steps are not shown. The means are not shown, the base station is not shown and over all system is not shown. The means that do the steps are not shown. What the node is made of in order to have the claimed means is not disclosed. How the means are interconnected in the node is not shown. These steps and means are only known by the inventor and are not disclosed to the examiner or the public.

Response to Arguments

6. Applicant's arguments filed February 19, 2009 have been fully considered but they are not persuasive.

Enablement requirement of 35 USC 112 is satisfied if the specification contains description that enables one skilled in the art to make and use the claimed invention (Fiers v. Sugano, 25 USPQ2d 1601). The examiner, in holding that disclosure is not enabling, can rely upon sound scientific reasoning as acceptable alternative to patents and printed publications. Lack of working examples is not controlling in determining whether disclosure meets enablement requirement of 35 USC § 112. A patent applicant who chooses to forego exemplification and bases utility on broad terminology and general allegations runs risk that, unless one with ordinary skill in art would accept allegations as obviously valid and correct, examiner may properly ask for evidence to substantiate them (Ex parte Sudilovsky, 21 USPQ2d 1702).

“*New matter*” prohibition of 35 USC §112 plays an important role in establishing the filing date of the application as prima facie date of the invention. Patent laws do not permit the insertion of additional descriptive matter subsequent to the filing date in order to complete the disclosure so as to conform the specification’s description of the invention to statutory standard (*Ex parte Maizel*, 28 USPQ2d 1662). If new matter is added to the claims, the examiner should reject the claims under 35 U.S.C. 112, first paragraph - written description requirement. *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981).

Applicants are trying to claim specific details of components or steps which the specification fails to detail. Nor does applicant's attorney specifically point out support in the specification each and every newly claimed step or means.

Allowable Subject Matter

7. Claims 1 is allowed.
8. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Conclusion

9. If applicants wish to request for an interview, an *"Applicant Initiated Interview Request"* form (PTOL-413A) should be submitted to the examiner prior to the interview in order to permit the examiner to prepare in advance for the interview and to focus on the issues to be discussed. This form should identify the participants of the interview, the proposed date of the interview, whether the interview will be personal, telephonic, or video conference, and should include a brief description of the issues to be discussed. A copy of the completed *"Applicant Initiated Interview Request"* form should be attached to the Interview Summary form, PTOL-413 at the completion of the interview and a copy should be given to applicant or applicant's representative.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

USPTO Announces Delay of Effective and Applicability Dates of New BPAI Rules

In the December 10, 2008 edition of the Federal Register, the USPTO published an announcement noting that the final rule relating to practice before the Board of Patent Appeals and Interferences (BPAI) in ex parte appeals will not take effect on December 10 as originally scheduled. New effective and applicability dates will be identified in a subsequent announcement.

In the interim, the USPTO will continue to accept appeal briefs in either the current format, or the new format as outlined in the final rule.

Read the Federal Register announcement: <http://edocket.access.gpo.gov/2008/pdf/E8-29297.pdf>

Link to final rule amending the rules governing practice before the BPAI (June 10, 2008):
<http://www.uspto.gov/web/offices/com/sol/notices/73fr32938.pdf>

11. If applicants request an interview after this **final rejection**, prior to the interview, the intended purpose and content of the interview should be presented briefly, in writing.
Such an interview may be granted if the examiner is convinced that disposal or clarification for appeal may be accomplished with only nominal further consideration.
Interviews merely to **restate arguments** of record or to **discuss new limitations** which would require more than nominal reconsideration or new search will be denied.
12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
13. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **WILLIAM D. CUMMING** whose telephone number is 571-272-7861. The examiner can normally be reached on Tuesday- Friday, 11:00am-8:00pm.

15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne Bost can be reached on 571-272-7023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/WILLIAM D CUMMING/
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